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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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JONES DAY 222 EAST 41ST ST NEW YORK, NY 10017			EXAMINER FISHER, PAUL R	
			ART UNIT 3689	PAPER NUMBER
			MAIL DATE 08/03/2010	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/790,469

Applicant(s)

MUELLER, SCOTT

Examiner

PAUL FISHER

Art Unit

3689

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 June 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 and 26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 and 26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 May 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/GS/US)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

1. Request for Continued Examination submitted on June 11, 2010 has been acknowledged. Claims 1-17 and 26 are currently pending and have been considered below.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 11, 2010 has been entered.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-17 and 26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The prior amendment filed on August 3, 2009

included limitations that can not be found in the applicant's originally filed specification specifically in claim 1, "wherein the maximum expected number is equal to the average number of repair order requests per time period multiplied by the number of days the service center is open per time period multiplied by four multiplied by a tire tread index" this limitation is contrary to what is found in the applicants originally filed specification. It appears that this calculation accounts for the time period twice thus inflating the maximum by a factor of the time period. This is contrary to what was originally filed and the Examiner asserts that one of skill in the art would not have known to use this value since it gives a maximum value which is far greater than should be expected. Claim 12 also recites similar limitations. The dependent claims are rejected upon the same rationale.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-17 and 26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
5. In claim 1, the recited limitation, "wherein the maximum expected number is equal to the average number of repair order requests per time period multiplied by the number of days the service center is open per time period multiplied by four multiplied by a tire tread index", renders the claim indefinite. It is unclear to the Examiner if this calculation is supposed to read "average number of repair order requests per time period" or "average number of repair order requests per day". Since the calculation as

currently written can not be found in the specification and that it inflates the numbers by a factor of the time period, the Examiner is interpreting the claims to read "average number of repair order requests per day". Claim 12 also recites similar limitations. The dependent claims are rejected upon the same rationale.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-5, 7, 12-14 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burris et al. (US 2003/0208394 A1) hereafter Burris, in view of James H. Byrd: "Manage Your Inventory in Excel" (August 10, 2002) hereafter Byrd, further in view of VanHoose (4,773,011) hereafter VanHoose.

As per claim 1, Burris discloses a computer-implemented method of evaluating potential sales and business opportunities relating to establishing sales by calculating metrics that include a projected sales (Page 1, paragraph [0001]; discloses that the invention is directed toward tracking and forecasting sales) comprising:

collecting operational data from the service center (retail outlet) and storing the operational data in a computer-readable memory, wherein the operational data comprises an average number of repair order requests (average sales) per time period, a number of days the service center is open per time period and identification of one or

more carlines serviced (products) (Page 1, paragraph [0003]; discloses that it is old and well known to collect various forms of data, from various sources in order to predict potential sales, Page 1, paragraph [0015]; discloses that various sources of data are obtained, Page 3, paragraph [0028]; discloses that the information can be created based on the needs of the specific user. While the information gathered is not the same since no specific industry is mentioned in Burris, the Examiner asserts that the information itself would have been obvious to one of ordinary skill in the tire industry since it would have been obvious to know the number of requests, the hours of operation and the different products being sold all of this information would have been needed in calculating the potential sales);

calculating a the number of products to be sold per time period using one or more data processors and storing the maximum expected number in a computer-readable memory (Page 2, paragraph [0025]; discloses that the invention can forecast information such as future sales or projected sales as disclosed above various information is collected to calculate maximum expected sales in this case it is average number of products sold during a time period, which could be a year or a day if it is a year then it would be the same as the average number times the number of days in operation, multiplied by the number of products sold with tires it assumes that customers are likely to replace all four tires and the tread index which is a percentage in this case any percentage that reflects the possible trends such as tire wear),

determining a sales goal for each product line, the goal being a fraction of the maximum expected number using the one or more data processors and storing the tire

sales goal in a computer-readable memory (Page 3, paragraph [0032]; discloses that the system can automatically adjust a product schedule and it would obvious that the sales goal can be determined, further since it is a fraction it could be equal to the maximum projected sales or any other portion of those sales, this sales goal can be any fraction or percentage of the maximum sales); and

calculating the projected sales for the retailer using the one or more data processors by adding an average retail tire price for a product associated with a carline to a charge for services involved in selling that product to generate sum, multiplying the sum by the goal for the product line, and scaling to the time period to generate a tire sales for the product line, and summing the sales for each product line to determine a total projected sales for the retailer and storing the projected sales for the retailer in a computer-readable memory (Calculating the projected sales) (Page 2, paragraph [0025]; discloses that the invention can forecast information such as future sales or projected sales in this case it is average number of products sold during a time period, which could be a year or a day if it is a year then it would be the same as the average number times the number of days in operation, multiplied by the number of products sold with tires it assumes that customers are likely to replace all four tires and the tread index which is a percentage in this case any percentage that reflects the possible trends such as tire wear).

Burris fails to explicitly disclose that the calculation is for maximum sales wherein the maximum expected number is equal to the average number of repair order requests per time period multiplied by the number of days the service center is open per

time period multiplied by four (given that typically all four tires are replaced) multiplied by a tire tread index (which is the percentage of vehicles that are being serviced by an existing dealership service center that are in need of new tires, or the Potential customer base this is an arbitrary value or percentage), wherein the tire tread index varies according to carline and represents a percentage of cars serviced by the service center which have a tire tread depth less than a tread depth threshold;

Byrd, which discloses inventory management, teaches that it is old and well known to track and calculate Maximum sales (Page 3; teaches that part of tracking inventory is knowing sales volume like average sales, maximum sales, what is on hand, etc. all of this information would be necessary for calculating projected sales. Further Byrd page 3 recites that the system keeps and tracks Average sales, which is the sells during a typical ordering period. From this it would have been obvious to show what the average sales per day are which would be the sales during the operating hours of the facility. Page 4; discloses that this information is collected and stored in a computer through the use of software. Further still page 3; teaches there are safety quantity which include a risk aversion or some factor which helps assure that there is a minimum quantity at hand as stated in Byrd "you can't sell what you don't have" and the goal of the system is to assure you have stock on hand with out investing too much capital on inventory);

Therefore, from this teaching of Byrd, it would have been obvious to one skilled in the art at the time the invention to include in the system and method of Burris that the

calculations would include maximum sales as taught by Byrd since these calculations are considered to be basic necessities when calculating projected sales.

While neither Burris nor Byrd disclose specifics about particular industries or specifically that these methods can be used in the tire industry, the Examiner asserts that it would have been obvious to one having ordinary skill in the sale of tires that these concepts are required when forecasting tire sales. The formula for maximum sales is the average number of service requests per day multiplied by the number of days open in a time period which gives you the total number of service requests in that time period. This is then multiplied by four which is the average number of tires sold and most cars have four tires thus the maximum tires that can be sold on average is four and a wear factor which is tire tread index. This is related to the percentage of repair requests that require tire replacement. If the service center only sold tires this number would be 100% if they did other maintenance work it would clearly not be the only service request and thus would be a smaller percentage. There is no other way to calculate the maximum sales of tires, thus it would have been obvious to one having ordinary skill in tire sales to use this formula when calculating the maximum sales. When calculating the projected sales it would have been obvious to include the various services associated with installing a tire on a car, which include mounting and balancing these are known services when purchasing tires and would obviously have to be included in any calculation for determining the total sales or profit of selling tires.

VanHoose, which talks about a method of surveying, selecting, evaluating or servicing the tires of vehicles, teaches it is old and well known in the tire maintenance

industry that the number of tires that needs to be replaced in a fleet or collection of vehicles depends on the tread depth of the individual tires (Col. 2, line 43 through Col. 3, line 26 and Col. 3, line 59- Col. 4, line 36; teach that when determining what the number of tires need to be replace it is old and well known to check the tread depth of the tires and determine what a safe level of operation is for that particular tire, when the tire is no longer deemed save it is to be replaced. Further when combined with a wear rate it is possible to determine which vehicles would require tire replacement in the future, when combined with Burris and Byrd it would have been obvious to determine the maximum sales of tires based on the current tread depth of their customers' tires, by doing this they can determine what the potential number of tires that should be replaced is and thus determine the maximum tires to be sold).

Therefore, from this teaching of VanHoose, it would have been obvious to one skilled in the art at the time the invention to modify in the system and method of Burris and Byrd, to be used in the tire industry and to use tread depth as a measure to determine when a tire needs to be replaced as taught by VanHoose, for the purpose of accurately predicting the potential customer base of a repair facility, it would be necessary to determine how many tires would need to be replaced. By doing this the repair facility could accurately predict how many of its customers should be replacing their tires and thus how much money they can expect from this replacement.

The Examiner asserts that the type of data in this case information regarding the sale of tires is considered to be non-functional since the information itself fails to further limit the steps of the method in anyway. Furthermore, the type of information is

considered to be non-functional descriptive material since it has little if anything to the step of the method. When presented with a claim comprising descriptive material, an Examiner must determine whether the claimed non-functional descriptive material should be given patentable weight. The Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art. In re Gulack, 703 F.2d at 1384-85, 217 USPQ at 403; see also Diamond v. Diehr, 450 U.S. 175, 191, 209 USPQ 1, 10 (1981). However, the examiner need not give patentable weight to descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate. See In re Lowry, 32 F.3d 1336, 1338, 70 USPQ2d 1862, 1863-64 (Fed. Cir. 2004). Thus, when the prior art describes all the claimed structural and functional relationships between the descriptive material and the substrate, but the prior art describes a different descriptive material than the claim, then the descriptive material is non-functional and will not be given any patentable weight. Such a scenario presents no new and unobvious functional relationship between the descriptive material and the substrate. The Examiner asserts that the data identifying the type of information for the purchased good adds little, if anything, to the claimed structure of the system and thus does not serve as limitations on the claims to distinguish over the prior art. Any differences related merely to the meaning and information conveyed through data which does not explicitly alter or impact the steps is non-functional descriptive data. Except for the meaning to the human mind, the type of information gathered does not functionally relate to the

substrate and thus does not change the steps of the method as claimed. The subjective interpretation of the data does not patentably distinguish the claimed invention.

For example if the items for sale were computers and their corresponding parts would change. The operational data would pertain to average number of sales of computers or accessories, the hours the store would be open and the different computers for sale. The Maximum sales would depend on how many computers were sold on a given night with a set number of hours open. The index could refer to the percentage of customers who might have to have their systems upgraded or replaced. By replacing the information being gathered the steps do not change and therefore the information is non-functional. The Examiner asserts that the method is merely calculating projected sales based on average price of a product for each product line the services associated with the product and the sales goal which is based off the maximum possible sales. These principles can be adapted to any industry and are no specific to tire sales and thus the name given to the product is considered to be non-functional.

As per claim 2, the combination of Burris, Byrd and VanHoose teaches the above-enclosed invention, Burris further discloses that it is old and well known that the time period is one year (Page 1, paragraph [0004]; discloses that it is old and well known to run reports yearly).

As per claims 3 and 13, the combination of Burris, Byrd and VanHoose teaches the above-enclosed invention, while the combination of Burris, Byrd and VanHoose fails to explicitly disclose that the operational data further includes an employee pay rate per

hour, wherein a net profit is calculated based on the projected tire sales for the automotive service center and the employee pay rate per hour. However the Examiner asserts that this information would have been obvious to anyone working in the field of tire sales would take this information into consideration while projecting future sales, since to determine your profit you must include how much it costs to perform the service.

Further as stated in the above example given in claim 1, when selling computers the information gather could pertain to the number of new and refurbished computers the charge for diagnostic and the employee rate per hour since this information would be needed to determine the potential sales, for example if each new computer goes through a diagnostic before being sold and each system to calculate the sales one would need to calculate the price of each unit sold, and any service that would need to be performed on that system. To calculate the profits of the system the total sales would have to be determined, minus the money spent acquiring the parts and the money paid to employees. All of this information would be needed to determine projected profits.

Furthermore, the type of information is considered to be non-functional descriptive material since it has little if anything to the step of the method. When presented with a claim comprising descriptive material, an Examiner must determine whether the claimed non-functional descriptive material should be given patentable weight. The Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art. In re Gulack, 703 F.2d at 1384-85, 217 USPQ at 403; see also Diamond v. Diehr, 450 U.S. 175, 191,209

USPQ 1, 10 (1981). However, the examiner need not give patentable weight to descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate. See *In re Lowry*, 32 F.3d 1336, 1338, 70 USPQ2d 1862, 1863-64 (Fed. Cir. 2004). Thus, when the prior art describes all the claimed structural and functional relationships between the descriptive material and the substrate, but the prior art describes a different descriptive material than the claim, then the descriptive material is non-functional and will not be given any patentable weight. Such a scenario presents no new and unobvious functional relationship between the descriptive material and the substrate. The Examiner asserts that the data identifying the type of information for the purchased good adds little, if anything, to the claimed structure of the system and thus does not serve as limitations on the claims to distinguish over the prior art. Any differences related merely to the meaning and information conveyed through data which does not explicitly alter or impact the steps is non-functional descriptive data. Except for the meaning to the human mind, the type of information gathered does not functionally relate to the substrate and thus does not change the steps of the method as claimed. The subjective interpretation of the data does not patentably distinguish the claimed invention.

As per claims 4, 5 and 14 the combination of Burris, Byrd and VanHoose teaches the above-enclosed invention, while the combination of Burris, Byrd and VanHoose fails to explicitly disclose wherein the tire tread index is no greater than 30% or is 10% to about 15%.

However the Examiner asserts that the tire tread index could be any value the value of the index does not alter or change the method steps but rather only alters the output or final result. Unlike other percentages used to describe mechanical structures, this percentage does not impose any structural limits or changes to the claim in anyway, rather it is completely dependent on the customer market and how many people need tires. The Examiner asserts that this information is considered to be non-functional descriptive material. When presented with a claim comprising descriptive material, an Examiner must determine whether the claimed non-functional descriptive material should be given patentable weight. The Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art. In *re Gulack*, 703 F.2d at 1384-85, 217 USPQ at 403; see also *Diamond v. Diehr*, 450 U.S. 175, 191,209 USPQ 1, 10 (1981). However, the examiner need not give patentable weight to descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate. See *In re Lowry*, 32 F.3d 1336, 1338, 70 USPQ2d 1862, 1863-64 (Fed. Cir. 2004). Thus, when the prior art describes all the claimed structural and functional relationships between the descriptive material and the substrate, but the prior art describes a different descriptive material than the claim, then the descriptive material is non-functional and will not be given any patentable weight. Such a scenario presents no new and unobvious functional relationship between the descriptive material and the substrate. The Examiner asserts that the data identifying the type of information for the purchased good adds little, if anything, to the claimed structure of the system and thus does not serve as limitations

on the claims to distinguish over the prior art. Any differences related merely to the meaning and information conveyed through data which does not explicitly alter or impact the steps is non-functional descriptive data. Except for the meaning to the human mind, the type of information gathered does not functionally relate to the substrate and thus does not change the steps of the method as claimed. The subjective interpretation of the data does not patentably distinguish the claimed invention.

As per claim 7, the combination of Burris, Byrd and VanHoose teaches the above-enclosed invention, while the combination of Burris, Byrd and VanHoose fails to explicitly disclose where the existing service center is affiliated with a car dealership that sells new, used, and certified pre-owned cars.

However the Examiner asserts that the fact that the service center is affiliated with a car dealership that sells new, used, and certified pre-owned cars is specific to the tire industry but fails to limit the steps of the method in anyway. The Examiner asserts that this information is considered to be non-functional descriptive material. When presented with a claim comprising descriptive material, an Examiner must determine whether the claimed non-functional descriptive material should be given patentable weight. The Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art. In re Gulack, 703 F.2d at 1384-85, 217 USPQ at 403; see also Diamond v. Diehr, 450 U.S. 175, 191, 209 USPQ 1, 10 (1981). However, the examiner need not give patentable weight to descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate. See In re Lowry, 32 F.3d 1336, 1338, 70

USPQ2d 1862, 1863-64 (Fed. Cir. 2004). Thus, when the prior art describes all the claimed structural and functional relationships between the descriptive material and the substrate, but the prior art describes a different descriptive material than the claim, then the descriptive material is non-functional and will not be given any patentable weight. Such a scenario presents no new and unobvious functional relationship between the descriptive material and the substrate. The Examiner asserts that the data identifying the type of information for the purchased good adds little, if anything, to the claimed structure of the system and thus does not serve as limitations on the claims to distinguish over the prior art. Any differences related merely to the meaning and information conveyed through data which does not explicitly alter or impact the steps is non-functional descriptive data. Except for the meaning to the human mind, the type of information gathered does not functionally relate to the substrate and thus does not change the steps of the method as claimed. The subjective interpretation of the data does not patentably distinguish the claimed invention.

As per claim 12, Burris discloses a computer-implemented method of evaluating potential sales and business opportunities relating to establishing sales by calculating metric that include a business opportunity metric (Page 1, paragraph [0001]; discloses that the invention is directed toward tracking and forecasting sales) comprising:

collecting operational data from the service center (retail outlet) and storing the operational data in a computer-readable memory, wherein the operational data comprises an average number of repair order requests (average sales) per time period, a number of days the service center is open per time period, and an identification of one

or more carlines serviced (products) (Page 1, paragraph [0003]; discloses that it is old and well known to collect various forms of data, from various sources in order to predict potential sales, Page 1, paragraph [0015]; discloses that various sources of data are obtained, Page 3, paragraph [0028]; discloses that the information can be created based on the needs of the specific user. While the information gathered is not the same since no specific industry is mentioned in Burris, the Examiner asserts that the information itself would have been obvious to one of ordinary skill in the tire industry since it would have been obvious to know the number of requests, the hours of operation and the different products being sold all of this information would have been needed in calculating the potential sales);

calculating a the number of products to be sold per time period using one or more data processors and storing the maximum expected number in a computer-readable memory (Page 2, paragraph [0025]; discloses that the invention can forecast information such as future sales or projected sales as disclosed above various information is collected to calculate maximum expected sales in this case it is average number of products sold during a time period, which could be a year or a day if it is a year then it would be the same as the average number times the number of days in operation, multiplied by the number of products sold with tires it assumes that customers are likely to replace all four tires and the tread index which is a percentage in this case any percentage that reflects the possible trends such as tire wear),

determining a sales goal for each product line, the goal being a fraction of the maximum expected number using the one or more data processors and storing the tire

sales goal in a computer-readable memory (Page 3, paragraph [0032]; discloses that the system can automatically adjust a product schedule and it would obvious that the sales goal can be determined, further since it is a fraction it could be equal to the maximum projected sales or any other portion of those sales, this sales goal can be any fraction or percentage of the maximum sales); and

calculating the projected sales for the retailer using the one or more data processors by adding an average retail tire price for a product associated with a carline to a charge for services involved in selling that product to generate sum, multiplying the sum by the goal for the product line, and scaling to the time period to generate a tire sales for the product line, and summing the sales for each product line to determine a total projected sales for the retailer and storing the projected sales for the retailer in a computer-readable memory (Calculating the projected sales) (Page 2, paragraph [0025]; discloses that the invention can forecast information such as future sales or projected sales in this case it is average number of products sold during a time period, which could be a year or a day if it is a year then it would be the same as the average number times the number of days in operation, multiplied by the number of products sold with tires it assumes that customers are likely to replace all four tires and the tread index which is a percentage in this case any percentage that reflects the possible trends such as tire wear).

calculating a certified pre-owned savings associated with tire sales using the one or more data processors and storing the projected tire sales in a computer-readable memory, wherein the certified pre-owned savings is calculated by comparing a cost

associated with outsourcing replacement of certified pre-owned car tires with a cost associated with internally supplying new tires to the certified pre-owned cars (Page 2, paragraph [0025]; discloses that the invention can forecast information, it would be obvious that this information could be saving about different possible outcomes); and

calculating the business opportunity metric using the one or more data processors and storing the business opportunity metric in a computer-readable memory by adding together the total projected sales and the savings (Page 2, paragraph [0025]; discloses that the invention can forecast information, it would have been obvious to calculate different scenarios to help determine what is the best course of action in a new venture such as determining the savings associated with one choice compared to another the information itself being about a tire sales adds little if anything to claimed method).

Burris fails to explicitly disclose that the calculation is for maximum sales wherein the maximum expected number is equal to the average number of repair order requests per time period multiplied by the number of days the service center is open per time period multiplied by four (given that typically all four tires are replaced) multiplied by a tire tread index (which is the percentage of vehicles that are being serviced by an existing dealership service center that are in need of new tires, or the Potential customer base this is an arbitrary value or percentage), wherein the tire tread index varies according to carline and represents a percentage of cars serviced by the service center which have a tire tread depth less than a treat depth threshold;

Byrd, which discloses inventory management, teaches that it is old and well known to track and calculate Maximum sales (Page 3; teaches that part of tracking inventory is knowing sales volume like average sales, maximum sales, what is on hand, etc. all of this information would be necessary for calculating projected sales. Further Byrd page 3 recites that the system keeps and tracks Average sales, which is the sells during a typical ordering period. From this it would have been obvious to show what the average sales per day are which would be the sales during the operating hours of the facility. Page 4; discloses that this information is collected and stored in a computer through the use of software. Further still page 3; teaches there are safety quantity which include a risk aversion or some factor which helps assure that there is a minimum quantity at hand as stated in Byrd "you can't sell what you don't have" and the goal of the system is to assure you have stock on hand with out investing too much capital on inventory);

Therefore, from this teaching of Byrd, it would have been obvious to one skilled in the art at the time the invention to include in the system and method of Burris that the calculations would include maximum sales as taught by Byrd since these calculations are considered to be basic necessities when calculating projected sales.

While neither Burris nor Byrd disclose specifics about particular industries or specifically that these methods can be used in the tire industry, the Examiner asserts that it would have been obvious to one having ordinary skill in the sale of tires that these concepts are required when forecasting tire sales. The formula for maximum sales is the average number of service requests per day multiplied by the number of days open

in a time period which gives you the total number of service requests in that time period. This is then multiplied by four which is the average number of tires sold and most cars have four tires thus the maximum tires that can be sold on average is four and a wear factor which is tire tread index. This is related to the percentage of repair requests that require tire replacement. If the service center only sold tires this number would be 100% if they did other maintenance work it would clearly not be the only service request and thus would be a smaller percentage. There is no other way to calculate the maximum sales of tires, thus it would have been obvious to one having ordinary skill in tire sales to use this formula when calculating the maximum sales. When calculating the projected sales it would have been obvious to include the various services associated with installing a tire on a car, which include mounting and balancing these are known services when purchasing tires and would obviously have to be included in any calculation for determining the total sales or profit of selling tires.

VanHoose, which talks about a method of surveying, selecting, evaluating or servicing the tires of vehicles, teaches it is old and well known in the tire maintenance industry that the number of tires that needs to be replaced in a fleet or collection of vehicles depends on the tread depth of the individual tires (Col. 2, line 43 through Col. 3, line 26 and Col. 3, line 59- Col. 4, line 36; teach that when determining what the number of tires need to be replace it is old and well known to check the tread depth of the tires and determine what a safe level of operation is for that particular tire, when the tire is no longer deemed safe it is to be replaced. Further when combined with a wear rate it is possible to determine which vehicles would require tire replacement in the

future, when combined with Burris and Byrd it would have been obvious to determine the maximum sales of tires based on the current tread depth of their customers' tires, by doing this they can determine what the potential number of tires that should be replaced is and thus determine the maximum tires to be sold).

Therefore, from this teaching of VanHoose, it would have been obvious to one skilled in the art at the time the invention to modify in the system and method of Burris and Byrd, to be used in the tire industry and to use tread depth as a measure to determine when a tire needs to be replaced as taught by VanHoose, for the purpose of accurately predicting the potential customer base of a repair facility, it would be necessary to determine how many tires would need to be replaced. By doing this the repair facility could accurately predict how many of its customers should be replacing their tires and thus how much money they can expect from this replacement.

The Examiner asserts that the type of data in this case information regarding the sale of tires is considered to be non-functional since the information itself fails to further limit the steps of the method in anyway. Furthermore, the type of information is considered to be non-functional descriptive material since it has little if anything to the step of the method. When presented with a claim comprising descriptive material, an Examiner must determine whether the claimed non-functional descriptive material should be given patentable weight. The Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art. In re Gulack, 703 F.2d at 1384-85, 217 USPQ at 403; see also Diamond v. Diehr, 450 U.S. 175, 191, 209 USPQ 1, 10 (1981). However, the examiner need not give

patentable weight to descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate. See *In re Lowry*, 32 F.3d 1336, 1338, 70 USPQ2d 1862, 1863-64 (Fed. Cir. 2004). Thus, when the prior art describes all the claimed structural and functional relationships between the descriptive material and the substrate, but the prior art describes a different descriptive material than the claim, then the descriptive material is non-functional and will not be given any patentable weight. Such a scenario presents no new and unobvious functional relationship between the descriptive material and the substrate. The Examiner asserts that the data identifying the type of information for the purchased good adds little, if anything, to the claimed structure of the system and thus does not serve as limitations on the claims to distinguish over the prior art. Any differences related merely to the meaning and information conveyed through data which does not explicitly alter or impact the steps is non-functional descriptive data. Except for the meaning to the human mind, the type of information gathered does not functionally relate to the substrate and thus does not change the steps of the method as claimed. The subjective interpretation of the data does not patentably distinguish the claimed invention.

For example if the items for sale were computers and their corresponding parts would change. The operational data would pertain to average number of sales of computers or accessories, the hours the store would be open and the different computers for sale. The Maximum sales would depend on how many computers were sold on a given night with a set number of hours open. The index could refer to the percentage of customers who might night to have their systems upgraded or replaced.

By replacing the information being gathered the steps do not change and therefore the information is non-functional. The savings could come from outsourcing repairs to refurbished computers which could have out dated elements and require more investment then current systems.

As per claim 26, the combination of Burris, Byrd and VanHoose teaches the above-enclosed invention, VanHoose further teaches wherein the tire tread index for a carline (products that might need to be replaced) by measuring a tread depth for a plurality of cars in the carline, determining a number of the plurality of cars having a tire tread depth less than a tread depth threshold, and determining the tire tread index based on the number of cars having a tire tread depth less than the tread depth and the number of cars in the plurality of cars in the carline (Col. 2, line 43 through Col. 3, line 26 and Col. 3, line 59- Col. 4, line 36; teach that when determining what the number of tires need to be replace it is old and well known to check the tread depth of the tires and determine what a safe level of operation is for that particular tire, when the tire is no longer deemed save it is to be replaced).

8. **Claims 6, 8-11, and 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burris et al. (US 2003/0208394 A1) hereafter Burris, in view of Byrd, further in view of VanHoose (4,773,011) hereafter VanHoose, further in view of Examiner's Official Notice.**

As per claim 6 and 15, the combination of Burris, Byrd and VanHoose teaches the above-enclosed invention, while Burris does disclose making various calculations based on the information being gathered (Page 2, paragraph [0025]; discloses that the

invention can forecast information such as future sales or projected sales). However, it fails to explicitly disclose calculating total savings, net profit, warranty costs, capital investment, return on investment, and total equipment costs using the projected tire sales for the automotive service center.

However, the Examiner is taking official notice that it is old and well known to make various calculations and that the calculations themselves are not novel. It is common for a company or business to calculate total savings, net profit, warranty costs, capital investment, return on investment, and total equipment costs as part of doing business. It is often required to calculate net profit for example to determine if the venture will be a profitable one, or return on investment to determine if the investment is sound and if investors will back the venture.

Therefore, from this teaching of Examiner's Official Notice, it would have been obvious to one skilled in the art at the time the invention to include in the system and method provided by the combination of Burris and Byrd with the basic calculations taught by the Examiner's Official Notice since these calculations are considered to be basic calculations that all businesses perform to ensure that they are making a sound financial decision.

As per claims 8 and 17, the combination of Burris, Byrd and VanHoose teaches the above-enclosed invention, while Burris does disclose making various calculations based on the information being gathered (Page 2, paragraph [0025]; discloses that the invention can forecast information such as future sales or projected sales). However, it fails to explicitly disclose calculating of capital investment cost, wherein the capital

investment cost is determined by adding a cost of purchasing tire installation equipment and an inventory investment cost, wherein the inventory investment cost is calculated by dividing the projected tire sales by the inventory turn goal and multiplying by an average wholesale tire price associated with a carline.

However, the Examiner is taking official notice that it is old and well known to make various calculations and that the calculations would include such calculations such as capital investment cost. A company would do this sort of calculation to determine what the investment is for the product and to ensure they can afford to take on these new costs.

Therefore, from this teaching of Examiner's Official Notice, it would have been obvious to one skilled in the art at the time the invention to include in the system and method provided by the combination of Burris and Byrd with the basic calculations taught by the Examiner's Official Notice since these calculations are considered to be basic calculations that all businesses perform to ensure that they are making a sound financial decision.

As per claim 9, the combination of Burris, Byrd and VanHoose teaches the above-enclosed invention, Burris does disclose making various calculations based on the information being gathered (Page 2, paragraph [0025]; discloses that the invention can forecast information such as future sales or projected sales). Byrd teaches tracking status of inventory (Page 5, under the status heading; teaches that inventory is tracked in various ways).

However the combination fails to explicitly disclose including the calculating of an inventory space requirement.

However, the Examiner is taking official notice that it is old and well known to make various calculations and that the calculations would include such calculations such as inventory space requirements. A company would do this sort of calculation to determine what the inventory space requirements are so they don't have goods they can't stock.

Therefore, from this teaching of Examiner's Official Notice, it would have been obvious to one skilled in the art at the time the invention to include in the system and method provided by the combination of Burris and Byrd with the basic calculations taught by the Examiner's Official Notice since these calculations are considered to be basic calculations that all businesses perform to ensure that they are making a sound financial decision and not taking on obligations they can't maintain.

As per claim 10, the combination of Burris, Byrd and VanHoose teaches the above-enclosed invention, Burris does disclose making various calculations based on the information being gathered (Page 2, paragraph [0025]; discloses that the invention can forecast information such as future sales or projected sales).

However the combination fails to explicitly disclose including the calculating a cost of satisfying warranty claims wherein the cost is determined by multiplying a number of new annual car sales for a dealership by a warranty factor or number of warranty claims.

However, the Examiner is taking official notice that it is old and well known to make various calculations and that the calculations would include such calculations such as cost of satisfying warranty claims. A company would do this sort of calculation to determine what the cost of fulfilling warranties would be, given that the information is directed toward tires it is old and well know that tires come with warranties and thus would have a related cost associated with fulfilling those warranties.

Therefore, from this teaching of Examiner's Official Notice, it would have been obvious to one skilled in the art at the time the invention to include in the system and method provided by the combination of Burris and Byrd with the basic calculations taught by the Examiner's Official Notice since these calculations are considered to be basic calculations that all businesses perform to ensure that they are making a sound financial decision and not taking on obligations they can't maintain.

As per claim 11, the combination of Burris, Byrd and VanHoose teaches the above-enclosed invention, Burris does disclose making various calculations based on the information being gathered (Page 2, paragraph [0025]; discloses that the invention can forecast information such as future sales or projected sales).

However the combination fails to explicitly disclose including the calculating a loyalty factor, wherein the loyalty factor is determined by dividing an annual tires sold by a loyalty variable.

However, the Examiner is taking official notice that it is old and well known to make various calculations and that the calculations would include such calculations such as a loyalty factor. A company would do this sort of calculation to determine what

the loyalty of their customers would be based on how often they return to the service center for maintenance.

Therefore, from this teaching of Examiner's Official Notice, it would have been obvious to one skilled in the art at the time the invention to include in the system and method provided by the combination of Burris and Byrd with the basic calculations taught by the Examiner's Official Notice since these calculations are considered to be basic calculations that all businesses perform to ensure that they maintain a good relationship with their customers and ensure that they have future sales.

As per claim 16, the combination of Burris, Byrd and VanHoose teaches the above-enclosed invention, while Burris does disclose making various calculations based on the information being gathered (Page 2, paragraph [0025]; discloses that the invention can forecast information such as future sales or projected sales).

However fails to explicitly disclose wherein the cost associated with internally supplying new tires is calculated by multiplying a number of annual certified pre-owned cars sold by a pre-owned car service goal and adding labor costs for replacing tires, and wherein the cost associated with outsourcing the replacement is calculated using an average retail tire price.

However, the Examiner is taking official notice that it is old and well known to make various calculations and that the calculations would include such calculations such as a comparison between in house costs and outsourcing a job. The details of this job would depend on the industry and the products being sold. A business dealing in tire resale would to consider the number of possible tires they would have to replace as well

as the cost of having them installed meaning how much they would have to pay workers. These calculations would have to be done simply to know if it is cost effective to offer this service while still maintaining a competitive cost for the service. It is often the procedure of a company to evaluate various options in order to discover the most cost effective and profitable solution.

Therefore, from this teaching of Examiner's Official Notice, it would have been obvious to one skilled in the art at the time the invention to include in the system and method provided by the combination of Burris and Byrd with the basic calculations taught by the Examiner's Official Notice since these calculations are considered to be basic calculations that all businesses perform to ensure that they maintain to evaluate various options in order to discover the most cost effective and profitable solution.

Response to Arguments

9. Applicant's arguments filed June 11, 2010 have been fully considered but they are not persuasive.
10. In response to the applicant's arguments concerning the 112 rejections, all previous 112 rejections have been removed.
11. Applicant's arguments with respect to claims 1-17 and 26 have been considered but are moot in view of the new ground(s) of rejection.
12. In response to the applicant's arguments regarding claims 4, 5, and 14, particularly that weight must be given to the ranges which have been recited, the Examiner respectfully disagrees. As shown above unlike ranges which require structural

limitations or changes to the way a process is performed or carried out, the ranges in these claims do not alter or change the structure or process in anyway. Further as shown in the new reference VanHoose these ranges could change depending on the conditions of the cars which are being serviced, that is to say if the cars progressively have worse tread depth the index will change accordingly. This is to say that this variable is not a set variable but rather changes depending on the vehicles it is applied to. Thus since it is variable it can not change the process or structure but rather only the value which is being sought after in the first place. For these reasons the rejections have been maintained.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PAUL FISHER whose telephone number is (571)270-5097. The examiner can normally be reached on Mon/Fri [8am/4:30pm].

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janice Mooneyham can be reached on (571) 272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/P. R. F./
Examiner, Art Unit 3689

/Dennis Ruhl/
Primary Examiner, Art Unit 3689